

REMARKS/ARGUMENTS

The rejections presented in the Office action dated December 17, 2004 have been considered. Claims 1-39 remain pending in the application. The allowability of Claim 36 is acknowledged, and the Applicant thanks the Examiner for favorable consideration of this claim. Reconsideration of the remaining pending claims and allowance of the application in view of the present response is respectfully requested.

Claims 1-3, 8-31, 33-35, 38, and 39 stand rejected under 35 U.S.C. §102(e) as being anticipated by U.S. Publication No. 2003/0013434 to Rosenberg et al. (hereinafter *Rosenberg*). Applicants respectfully traverse the rejection. To anticipate a claim the reference must teach every element of the claim, and it is respectfully submitted that *Rosenberg* does not meet this standard.

“A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” MPEP 2131, quoting *Verdegaal Bros. v. Union Oil Co. of California*, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). “The identical invention must be shown in as complete detail as is contained in the patent claim; *i.e.* every element of the claimed invention must be literally present, arranged as in the claim.” MPEP 2131, quoting *Richardson v. Suzuki Motor Co.*, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). The Applicant submits that *Rosenberg* does not teach every element of independent Claims 1, 21, 24, 38, and 39, and therefore fails to anticipate Claims 1, 21, 24, 38, and 39.

Independent Claims 1, 21, 24, 38, and 39 are directed to provisioning a mobile terminal by a provisioning Web service for use by a network service application provided by the network service. Provisioning includes configuring the mobile terminal for use of the application and delivering the application to the mobile terminal. It is first pointed out that *Rosenberg* is directed to a Web browser interface used to replace the actions formerly required by a human customer service representative [0014]. The mobile user maneuvers to a provider Web page and fills in data forms [0022]. In response, the user is provided with an activation code that contains the provisioning data, such as IP address and preferences [0027]. Then the user “enters the activation code into a window provided by the activation

module on the device's screen. The activation module decodes the activation code back into the IP address and side preference and programs them into the wireless modem's memory, thereby activating the wireless services on the wireless device.” [0027]. Thus, *Rosenberg* does not teach provisioning the terminal via a provisioning Web service, because *Rosenberg* clearly teaches provisioning the terminal manually.

The Applicant respectfully submits that Web services is a specific term of art, and the fact that data may be accessed via the Web does not necessarily suggest that Web services are involved in providing that data. In particular, accessing a document from a Web site does not necessarily imply that a Web service is being invoked. A Web service generally refers to a self-contained modular application that can be published in a ready-to-use format, located, and invoked across the World Wide Web. When a Web service is deployed, other applications and Web services can locate and invoke the deployed service (see, e.g., Specification page 10, lines 10-21). In *Rosenberg*, an application is not invoked across the Web to provision the terminal; a Web document is merely accessed by the user via a browser to display an activation code. *Rosenberg* does not even describe the use of Web services to generate or access the user account documents, much less to provision the terminal. Even assuming *arguendo* that the browser accesses the Web document via Web services, the browser does not provision the terminal. Terminal configuration in *Rosenberg* is performed by the activation module (see. ref. no. 57 in FIG. 4)

In *Rosenberg* a browser is used only to retrieve user account documents, and neither the browser or any other component in *Rosenberg* invoke Web services to provision the terminal. The provisioning in *Rosenberg* is accomplished by a user typing in an activation code into an activation module that is running locally on the device (see, e.g., [0060]). The activation module as described in *Rosenberg* has a local user interface (e.g., “a window provided by activation module 46 on the screen of wireless device” and “typing the activation code,” [0060]), and *Rosenberg* does not disclose or otherwise suggest the activation module can interface with Web Services via the network to provision the terminal. As a result, *Rosenberg* merely teaches manual configuration of a terminal by a user who accesses a locally running process. *Rosenberg* does not teach provisioning the terminal by a provisioning Web service, therefore *Rosenberg* does not teach each and every

element of Claims 1, 21, 24, 38, and 39. Applicants submit, then, that Claims 1, 21, 24, 38, and 39 are in condition for allowance.

Dependent Claims 2-3, 8-20, 22-23, 25-31, and 33-35 are dependent from independent Claims 1, 21, and 24, respectively and also stand rejected under 35 U.S.C. §102(e) as being anticipated by *Rosenberg*. While Applicant does not acquiesce with the particular rejections to these dependent claims, these rejections are now moot in view of the remarks made in connection with independent Claims 1, 21, and 24. These dependent claims include all of the limitations of the base claim and any intervening claims, and recite additional features which further distinguish these claims from the cited references. Therefore, dependent Claims 2-3, 8-20, 22-23, 25-31, and 33-35 are also in condition for allowance.

Claims 4-7 stand rejected under 35 U.S.C. §103(a) as being unpatentable over *Rosenberg* in view of Scott Seely “Web Service description and Discovery Using UDDI, Part II”, Microsoft Corporation (hereinafter *Seely*). Applicants respectfully traverse the rejection.

According to MPEP §2142, to establish a prima facie case of obviousness under 35 U.S.C. §103:

- 1) there must be some suggestion or motivation either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings;
- 2) there must be a reasonable expectation of success; and
- 3) the prior art reference (or references when combined) must teach or suggest all the claim limitations.

The Applicant respectfully submits that the combination of *Rosenberg* in view of *Seely* does not teach or suggest all of the limitations of Claims 4-7. Further, the Applicant respectfully submits that there is no motivation to combine the reference teachings as suggested in the Office Action.

Dependent Claims 4-7 depend from independent Claim 1, and include all of the limitations of the base claim and any intervening claims, and recite additional features

which further distinguish these claims from the cited references. As argued in greater detail above, *Rosenberg* at least fails to teach provisioning a mobile terminal by a provisioning Web service, because *Rosenberg* teaches provisioning the terminal manually. Thus *Rosenberg* fails to anticipate independent Claim 1, and as a result fails to anticipate Claims 4-7. *Seely* fails to cure the deficiencies of *Rosenberg*. *Seely* merely teaches the basics of UDDI description and discovery, and does not teach or suggest any aspects of provisioning mobile devices. Therefore, the combination of *Rosenberg* and *Seely* fail to teach or suggest provisioning a mobile terminal by a provisioning Web service, and thus a *prima facie* case of obviousness has not been established.

In addition, there is no motivation to combine the *Rosenberg* and *Seely* as suggested in the Office Action. Neither *Rosenberg* nor *Seely* provides motivation to use Web services to provision a mobile terminal. *Rosenberg* teaches providing activation data to users via a Web page, and the user then enters the activation data into a locally running process. The use of Web services would provide no noticeable improvement to the techniques taught *Rosenberg*, because *Rosenberg* merely teaches the graphical presentation of an activation code to the user in a browser. Such graphical representations of data in a browser are well known in the art, and can be easily accomplished without the use of Web services, e.g., through the use of static or dynamic Web documents. In addition, the activation module in *Rosenberg* uses a local user interface and is not disclosed as having any network interface. Thus, there is no suggestion or motivation in *Rosenberg* to modify an activation module to provision a terminal via a network using Web services.

Seely teaches some basic implementation details of registering a Web service with a UDDI directory. In particular, *Seely* illustrates an example of implementing a “Logon” Web service for a fictional computer consulting service (e.g., p. 4, Classifying the Business and p. 6, Defining the Services). As with *Rosenberg*, *Seely* does not provide any motivation to provision a mobile terminal using Web services because *Seely* is merely a Web services tutorial relating to a fictional business. Although *Seely* may suggest some general advantages of Web services, applying the teaching of *Seely* to *Rosenberg* without some other motivation is tantamount to applying an impermissible hindsight analysis based on the Applicant’s teachings. “[I]mpermissible hindsight must be avoided and the legal

conclusion must be reached on the basis of the facts gleaned from the prior art.” MPEP §2142. Applicant respectfully submits that neither *Rosenberg*, *Seely*, nor knowledge generally available to one of ordinary skill in the art provides facts that would motivate combining the reference teachings. Therefore Applicant respectfully submits that a *prima facie* case of obviousness has not been established as to Claims 4-7, and that these claims are in condition for allowance.

Claim 32 stands rejected under 35 U.S.C. §103(a) as being unpatentable over *Rosenberg* and *Seely* further in view of U.S. Publication No. 2003/0207685 to Rankin (hereinafter *Rankin*). Applicants respectfully traverse the rejection. The Applicant respectfully submits that the combination of *Rosenberg* and *Seely* in view of *Rankin* does not teach or suggest all of the limitations of Claim 32.

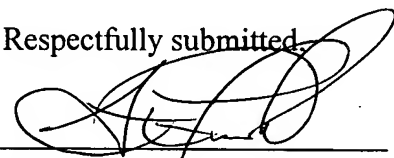
Dependent Claim 32 depends from independent Claim 24, and includes all of the limitations of the base claim and any intervening claims, and recites additional features which further distinguish this claim from the cited references. As argued in greater detail above, *Rosenberg* and *Seely* at least fail to teach provisioning a mobile terminal by a provisioning Web service, because *Rosenberg* teaches provisioning the terminal manually and *Seely* is silent on provisioning. Thus the combination of *Rosenberg* and *Seely* fail to anticipate independent Claim 24, and as a result fails to anticipate Claim 32. *Rankin* fails to cure the deficiencies of *Rosenberg* and *Seely*. *Rankin* is directed to delivering user data (e.g., music) to mobile users using short-range radio beacons based on stored profiles of the individual user (e.g., [0005], [0026], and [0043]). According to *Rankin*, “[t]he device is connectable to said at least one server or service provider” ([0026]), thus it must be presumed that the devices in *Rankin* are already provisioned. Therefore, the teaching of *Rankin* has no relation to provisioning mobile terminals, and as such *Rankin* does not teach provisioning a mobile terminal by a provisioning Web service. For at least this reason, the combination of *Rosenberg*, *Seely*, and *Rankin* do not teach each and every element of the Applicant’s invention, and thus do not support a case of *prima facie* obviousness.

In addition, *Rankin* does not even appear to teach or suggest the features relied upon in the Office Action to support the §103(a) rejection of Claim 32. As noted in the Office Action, the combination of *Rosenberg* and *Seely* do not disclose determining whether a

mobile terminal is not capable of direct delivery receipt by the data object delivery module, and if not, to provide an address of the application at the data object delivery module. In paragraph [0038] of *Rankin* relied upon in the Office Action, *Rankin* merely teaches tailoring of network Quality of Service (QoS) depending on stored profiles. In Claims 8, 17, and 18 of *Rankin*, also relied upon in the Office Action, *Rankin* merely teaches buffering data targeted for unavailable terminals. Nowhere does *Rankin* describe providing an address of a data object delivery module if the terminal is not capable of direct delivery receipt. Neither tailoring QoS as described in [0038], nor buffering server-side data as described in claims 8, 17, and 18 could be reasonably construed as providing an address at an application of a data object delivery module. As such, *Rankin* fails to teach or suggest this element of Claim 32, and a *prima facie* case of obviousness cannot be supported. Applicants respectfully submit that Claim 32 is therefore in condition for allowance.

The undersigned attorney of record invites the Examiner to contact him at 651-686-6633 (x110) to discuss any issues related to this case.

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Respectfully submitted

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